



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,063	02/21/2002	Masato Hoshi	50353-581	9001
41552	7590	10/12/2007		
MCDERMOTT, WILL & EMERY 4370 LA JOLLA VILLAGE DRIVE, SUITE 700 SAN DIEGO, CA 92122			EXAMINER ALLEN, WILLIAM J	
			ART UNIT 3625	PAPER NUMBER
			MAIL DATE 10/12/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/069,063

Applicant(s)

HOSHI, MASATO

Examiner

William J. Allen

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 22-33 is/are pending in the application.
- 4a) Of the above claim(s) 20,22-26,28 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-15,17-19,27 and 29 is/are rejected.
- 7) ☒ Claim(s) 6, 16, and 31-32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/6/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Prosecution History Summary

Claims 1-20 and 22-33 are pending.

Claim 21 has been canceled previously.

Claims 20, 22-26, 28, and 30 are withdrawn.

Claims 1-5, 7-15, 17-19, 27, and 29 are rejected as set forth below.

Claims 6, 16, and 31-32 are indicated as allowable subject matter.

Election/Restrictions

Applicant's election with traverse of group I, claims 1-19, 27, 29, and 31-32 in the reply filed on 8/13/2007 is acknowledged. The traversal is on the ground(s) that Applicant has received a previous action and, as such, a burden would not be placed on the Examiner. This is not found persuasive because it fails to distinctly point out the flaws in the Examiner's reasoning. The Examiner earnestly apologizes for the delay in prosecution, but hereby maintains the position set forth in the action mailed 7/13/2007. As set forth in that action, it is clear that the claims indeed represent restrictable subject matter. The requirement is still deemed proper and is therefore made FINAL.

Response to Arguments

Applicant's arguments filed 4/24/2007 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

Claims 6, 16 and 31-32 are objected to as being dependent upon a rejected base claim, but would be allowable if:

- A. (pertaining to claim 31) rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, and 35 U.S.C. 101 set forth below in this Office action **and**
- B. (pertaining to 6, 16, 31, and 32) rewritten in independent form to include all of the limitations of the base claim and any intervening claims.

Claim Objections

Claims 10-13 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim shall not serve as a basis for any other multiple dependent claim (note: claims 10-13 depend either directly or indirectly from other multiple dependent claims). See MPEP § 608.01(n).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- 1. Claims 1-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Regarding independent claim 1, Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute “descriptive material.” Abstract ideas, *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, *Schrader*, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” *The New IEEE Standard Dictionary of Electrical and Electronics Terms* 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited to music, literary works and a compilation or mere arrangement of data. Both types of “descriptive material” are nonstatutory when claimed as descriptive material per se. *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.

Claim 1 recites various “sections” that are drawn to disembodied computer code. As there is no storage and executing of these “sections”, the claim is merely directed to a computer program per se.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 2. Claims 1-13 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding independent claim 1, claim 1 recites “an address assigning section configured to assign an individual email address to a customer, to receive an electronic address message from the customer”. The Examiner notes that it is ambiguous as to which of the address assigning section and individual email address the clause “to receive an electronic message from the customer” is directed.

Regarding claim 32, claim 32 recites “receiving the subsequent email message”. There is insufficient antecedent basis for the claim.

Art Unit: 3625

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 7, 14-15, 17-18, 27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cockrill et al. (US 20030208442) in view of Fischer (US 20020010638).

Regarding claim 14, Cockrill teaches:

assigning an individual email address to a customer (see at least: abstract, 0018-0019, 0055-0056, 0068, Fig. 8,9 and 11). The Examiner notes that an email address and member identifier are assigned to the customer;

memorizing the individual email address (see at least: 0068);

receiving a subsequent electronic message from the customer (see at least: 0065-0069).

The Examiner notes that performing additional purchase requests, requesting to register with the system, performing additional log-ins, electronic information sent from the system to the customer, and the like constitute *subsequent electronic messages*.

Though Cockrill teaches the above, Cockrill does not expressly teach *determining whether a destination address of the subsequent electronic message is in agreement with the individual email address memorized*.

Art Unit: 3625

In the field of electronic commerce processing, Fischer teaches a system for performing electronic transaction between a user and a vendor utilizing an order list created offline (see at least: abstract). More specifically, Fischer teaches *determining whether a destination address of the subsequent electronic message is in agreement with the individual email address memorized* (see at least: 0022, 0033, Fig. 4). The Examiner notes that the vendor sending a confirmation email to the user constitutes determining whether the destination address (i.e. the vendor email of 0033) is in agreement with the individual address.

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Cockrill to have included the noted features as taught by Fischer because the incorporation of such features is no more than the predictable use of known prior art elements according to their established function.

Regarding claim 15, Cockrill in view of Fischer teaches:

wherein an individual email address is uniquely assigned to each customer in response to a first act of the customer, and memorized in association with customer information on the customer (see at least: Cockrill , 0018-0019, 0055-0056, 0065-0069);

wherein the customer information control method further comprises:

- *receiving information representing the first act of each customer, and customer information on the customer* (see at least: Cockrill , 0018-0019, 0055-0056, 0065-0069);

Art Unit: 3625

- *enabling each customer to express a second act subsequent to the first act by using the individual email address assigned to the customer (see at least: Cockrill, 0018-0019, 0055-0056, 0065-0069). The Examiner notes that after an additional purchase request a customer may perform subsequent logins as well as subsequent purchase requests using the unique customer identifier assigned to them.*

Regarding claim 17, Cockrill in view of Fischer teaches:

performing a first responsive sales support action in response to the first act from each customer (see at least: Cockrill, abstract, 0018, Fig. 8-9);

performing a second responsive sales support action in response to the subsequent electronic message from the customer only when the destination address of the subsequent electronic message is in agreement with the individual email address (see at least: Cockrill, 0065-0069, Fig. 8-9). The Examiner notes that the system of Cockrill is able to perform a second responsive sale action such as confirming purchases, performing additional purchases, etc. as a result of subsequent successful logins.

Regarding claim 18, Cockrill in view of Fischer teaches:

wherein the customer information control method further comprises performing a third responsive sales support action in response to the subsequent electronic message from the customer when the destination address of the subsequent electronic message is not in agreement with the individual email address (see at least: Cockrill, Fig. 9, 0068). The Examiner notes that

Art Unit: 3625

preventing accessing during failed authentication constitutes a *third responsive sales support action*.

Regarding claims 1-4, 7, 27, and 29, the limitations set forth in claims 1-4 closely parallel the limitations in claims 14-15 and 17-18. Claims 1-4 are thereby rejected under the same rationale.

Additionally, the Examiner notes that claims 27 and 29 both contain “if” statements. The Examiner further notes the recited “if” do not move to distinguish the claimed invention from the cited art. These phrases are conditional limitations with the noted “if” steps not necessarily performed. Accordingly, once the positively recited steps are satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios. [See: *In re Johnston*, 77 USPQ2d 1788 (CA FC 2006); *Intel Corp. v. Int'l Trade Comm'n*, 20 USPQ2d 1161 (Fed. Cir. 1991); MPEP §2106 II C].

Art Unit: 3625

4. **Claims 5, 8, and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cockrill in view of Fischer as applied above, and further in view of Almeida et al. (US 2004/0083125, herein referred to as Almeida).**

Regarding claim 5, Cockrill in view of Fischer teaches all of the above as noted but does not specifically teach *wherein the customer is notified of the individual email address by sending, to the customer address, an email message having the individual email address as a return address*. Almeida teaches *wherein the customer is notified of the individual email address by sending, to the customer address, an email message having the individual email address as a return address* (see at least: Fig. 1 and 2, abstract, 0030, 0052). The Examiner notes that when an email message is sent from the agent to vendors/customer the email has the return address indicating the individual email address of the agent. Furthermore, the agent handling the requests is assigned to those vendors/customers. It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Cockrill in view of Fischer to have included *wherein the customer is notified of the individual email address by sending, to the customer address, an email message having the individual email address as a return address* as taught by Almeida in order resolve communication problems between the various parties involved in purchasing auto insurance by providing a centralized communications environment, producing a cost-effective means of communication (see at least: Almeida, 0008, 0012).

Regarding claim 8, Cockrill in view of Fischer teaches all of the above and further teaches *wherein the memory section is configured to store the individual email address in association with the personal information and purchase-related information for each customer* (see at least: 0068). Cockrill in view of Fischer, however, does not teach *wherein the sales support section responds to the first act in the form of a computer-readable electronic message for a sales contract, by performing the sales support action to complete the sales contract; and wherein the sales support section is configured to perform the responsive sales support action in accordance with the customer information which comprises personal information and purchase-related information on a sales contract*. Almeida teaches *wherein the sales support section responds to the first act in the form of a computer-readable electronic message for a sales contract, by performing the sales support action to complete the sales contract; and wherein the sales support section is configured to perform the responsive sales support action in accordance with the customer information which comprises personal information and purchase-related information on a sales contract* (see at least: abstract, 0004-0014). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Cockrill to have included *wherein the sales support section responds to the first act in the form of a computer-readable electronic message for a sales contract, by performing the sales support action to complete the sales contract; and wherein the sales support section is configured to perform the responsive sales support action in accordance with the customer information which comprises personal information and purchase-related information on a sales contract* as taught by Almeida in order to provide an environment that facilitates doing business between an

Art Unit: 3625

insurance carrier, an insurance agent, a vendor, and a consumer in a more efficient manner (see at least: Almeida, abstract, 0013).

Regarding claim 12, Cockrill in view of Fischer in further view of Almeida further teaches *wherein the purchase-related information comprises credit information on credit for a customer, and the sales support section comprises an examining section to determine whether to allow credit or not, in accordance with the personal information and credit information* (see at least: 0016-0019).

Regarding claim 13, Cockrill in view of Fischer in further view of Almeida further teaches *wherein the customer information control system comprises a server system which comprises said address assigning section, said memory section, said communicating section, and said checking section, and at least one terminal comprising an input section to input the personal information and purchase-related information, and a communicating section to transmit the personal information and purchase-related information to the server system* (see at least: Fig. 8-11, 0065-0069).

Art Unit: 3625

5. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cockrill in view of Fischer in view of Almeida, as applied to claim 8 above, and further in view of Morohashi et al. (US 6105003).

Regarding claim 9, Cockrill in view of Fischer in view of Almeida teaches all of the above and further teach a sales support system (see at least: Cockrill, abstract; Almeida, abstract, 0004-0014). Cockrill in view of Fischer in view of Almeida does not teach *wherein the sales support section is configured to arrange a date of delivery in response to the first act of each customer for a sales contract, and to notify each customer of the date of deliver for the customer*. Morohashi teaches wherein the sales support section is configured to *arrange a date of delivery in response to the first act of each customer for a sales contract, and to notify each customer of the date of deliver for the customer* (see at least: col. 5 lines 58-65). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Cockrill in view of Fischer in view of Almeida to have included wherein the sales support section is configured to arrange a date of delivery in response to the first act of each customer for a sales contract, and to notify each customer of the date of deliver for the customer as taught by Morohashi in order to provide for quick sale of desired goods (see at least: abstract).

Regarding claim 10, Cockrill in view of Fischer in view of Almeida teaches all of the above as noted and further teaches *wherein the purchase-related information comprises order information* (see at least: abstract); *the sales support section comprises a product data storage section to store data on products* (see at least: 0061); *a data management section to retrieve data*

Art Unit: 3625

on a product specified by the order information, from the product data storage section (see at least: 0018). Cockrill in view of Almeida, however, does not teach an estimating section to draw up an estimate of the product in accordance with the information obtained from the product data storage section. Morohashi teaches an estimating section to draw up an estimate of the product in accordance with the information obtained from the product data storage section (see at least: abstract, Fig. 10, 12, 15A-15C, 16, and 20). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Cockrill in view of Fischer in view of Almeida to have included an estimating section to draw up an estimate of the product in accordance with the information obtained from the product data storage section as taught by Morohashi in order to provide for quick sale of desired goods with an estimate based on customer information received (see at least: abstract).

Regarding claim 11, Cockrill in view of Fischer in view of Almeida teaches all of the above but does not expressly teach *wherein the purchase-related information comprises trade-in information on a trade-in vehicle; the sales support section comprises a used car data storage section to store information on pre-owned vehicles; a data management section to retrieve data on a trade-in vehicle specified by the trade-in information, from the trade-in data storage section; and an assessing section to draw up an assessment of the trade-in vehicle in accordance with the data obtained from the trade-in data storage section. Morohashi teaches wherein the purchase-related information comprises trade-in information on a trade-in vehicle; the sales support section comprises a used car data storage section to store information on pre-owned vehicles; a data management section to retrieve data on a trade-in vehicle specified by the trade-*

Art Unit: 3625

in information, from the trade-in data storage section; and an assessing section to draw up an assessment of the trade-in vehicle in accordance with the data obtained from the trade-in data storage section (see at least: col. 5 lines 28-33, col. 6 lines 32-44, col. 9, lines 5-16, and Fig. 4).

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Cockrill in view of Fischer in view of Almeida to have included storing trade-in assessment information and pre-owned information as taught by Morohashi in order to provide for quick sale of desired goods with an estimate based on customer information received (see at least: abstract).

Art Unit: 3625

6. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cockrill in view of Fischer as applied to claim 18 in further view of Official Notice.

Regarding claim 19, claim 19 is directed to submitting, modifying, and communicating to the customer that a modification has not been entered via email. Cockrill further teaches providing the ability of a user to submit and modify orders (see at least: Fig. 8-11, 0092). Cockrill further teaches the system having the capability to resubmit or cancel accounts as a result of problems with the user accounts and confirming outstanding orders with customers (see at least: 0079, 0071). Additionally, Cockrill shows the user of a customer email address in performing necessary purchase steps, though Cockrill does not explicitly show the steps of submitting orders, modifying orders, and being notified that alterations to the accounts are done via an electronic message such as *an email*. The Examiner takes the position that it was old and well known in the art to allow orders, modifications, and various other communications involved with online purchasing to be sent via *email*. It would have been obvious to one of ordinary skill in the art at the time of invention to have included submitting and modifying orders via email, and notifying customer of unaccepted modifications via email as taught by official notice in order to provide an easy means of communication between a customer and a business entity. Additionally, applicant has not persuasively demonstrated the criticality of providing this step versus the steps disclosed by Cockrill.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US 6285984 discloses an internet-audiotext electronic advertising system with anonymous bidirectional messaging
- PYO 892 reference N teaches an electronic business negotiation system utilizing a common mailbox

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Allen whose telephone number is (571) 272-1443. The examiner can normally be reached on 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William Allen
Patent Examiner
October 3, 2007

A handwritten signature in black ink, appearing to read 'Mark Fadok', with a long horizontal flourish extending to the right.

Mark Fadok

Primary Examiner